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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

TRAN, THAI Q

ART UNIT PAPER NUMBER

2616

DATE MAILED: 10/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/368,792

Applicant(s)

STANDIFORD ET AL.

Examiner

Thai Tran

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 August 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. In view of the Appellant's Brief filed on April 13, 2004, PROSECUTION IS HEREBY REOPENED. New grounds of rejections are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final; or, (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

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not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1, 3-6, 9-11, 14-19, and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Menezes et al (US Patent No. 4,365,313).

Regarding claim 1, Menezes et al discloses a video editing apparatus (Fig. 1), the apparatus comprising:

- a video tape recorder (source VTR disclosed in col. 5, lines 4-16) for producing video output;

- at least one recorder (destination VTR disclosed in col. 5, lines 4-16) employing a storage medium for storing video signal reproduced from the video tape recorder, wherein said video tape recorder and said storage medium are disposed within a single container; and

- a key frame marker (the edit-in switch 82, edit-out switch 86 and mark enable switch 90 disclosed in col. 9, lines 30-41) for inserting at least one marker to the video signal reproduced from the video tape recorder. However, Menezes et al does not specifically disclose the claimed an analog video cassette player, an analog to digital converter for converting said analog video output into digital data and the at least one recorder is digital video recorder.

Menezes et al teaches in col. 5, lines 4-16 that "In video editing apparatus, video signals that are recorded on one medium are transferred, or recorded, onto another medium. Although such record media may comprise magnetic tape, magnetic disks,

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and other conventional recording medium, it will be assumed, for the purpose of the present discussion, that magnetic tape is used.”

It is noted that an analog video cassette player and digital video recorder having an analog to digital converter and removable digital storage medium such as digital video cassette recorder are old and well known in the art and; therefore, Official Notice is taken.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well known analog video cassette player and digital video recorder having an analog to digital converter and removable digital storage medium since it merely amounts to selecting an alternative equivalent recording medium because Menezes et al teaches that any conventional video recorder can be used or in order to increase the flexibility of the system of Menezes and to increase the quality of the edited videos signal because the user can selected any desired video cassette tape, which can be removable from the video cassette recorder, to be edited and digital video recorder has higher quality than the analog video recorder.

Regarding claim 3, Menezes discloses all the claimed limitations as discussed in claim 1 above except for providing wherein the video cassette player employs a VHS format.

It is noted that video cassette player having VHS format is also old and well known in the art and; therefore, Official Notice is taken.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well known VHS format recorder since it merely amounts to

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selecting an alternative equivalent recording medium because Menezes et al teaches that any conventional video recorder can be used.

Regarding claim 4, Menezes discloses all the claimed limitations as discussed in claim 1 above except for providing wherein the digital storage medium is one of a CD R or a CD RW.

It is noted that CD R or CD RW is also old and well known in the art and; therefore, Official Notice is again taken.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well known CD R or CD RW since it merely amounts to selecting an alternative equivalent recording medium because Menezes et al teaches that any conventional video recorder can be used.

Regarding claim 5, Menezes discloses all the claimed limitations as discussed in claim 1 above except for providing wherein the digital storage medium is a recordable DVD.

It is noted that DVD player is old and well known in the art and; therefore, Official Notice is taken.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well known DVD since it merely amounts to selecting an alternative equivalent recording medium because Menezes et al teaches that any conventional video recorder can be used.

Regarding claim 6, the claimed wherein the digital storage medium is selectable by the user is present in the digital video recorder having removable digital storage

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medium as discussed in claim 1 because the user can select different digital storage medium.

Regarding claim 8, Menezes discloses all the claimed limitations as discussed in claim 1 above except for providing wherein the video cassette player employs the 8 mm format.

It is noted that video cassette player having 8mm format is old and well known in the art and; therefore, Official Notice is taken.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well known 8mm format recorder since it merely amounts to selecting an alternative equivalent recording medium because Menezes et al teaches that any conventional video recorder can be used.

Method claim 10 is rejected for the same reasons as discussed in the corresponding apparatus claim 1 above

Regarding claim 11, the user can determines a required digital storage format prior to said step of converting based upon detection of a format of said inserted storage medium.

Method claim 14 is rejected for the same reasons as discussed in the corresponding apparatus claim 4 above

Regarding claim 15, Menezes discloses all the claimed limitations as discussed in claim 1 above except for providing wherein the digital storage medium is digital tape.

It is noted video cassette player having digital tape is also old and well known in the art and; therefore, Official Notice is taken.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well known digital tape recorder since it merely amounts to selecting an alternative equivalent recording medium because Menezes et al teaches that any conventional video recorder can be used.

Method claim 17 is rejected for the same reasons as discussed in the corresponding apparatus claim 3 above.

Method claim 18 is rejected for the same reasons as discussed in the corresponding apparatus claim 9 above.

Apparatus claim 19 is rejected for the same reasons as discussed in claims 1 and 4-5 above.

Regarding claim 21, the claimed removing the digital storage medium from said container after storing said digital video data in said digital storage medium is present in the digital video recorder having removable digital storage medium as discussed in claim 1 because the user can remove the digital storage medium from the editing system after storing the digital video data.

Regarding claim 22, the claimed wherein the digital storage medium is insertable into and removable from said single container is present in the digital video recorder having removable digital storage medium as discussed in claim 1 because the user can insert or remove the digital storage medium.

4. Claims 2, 7-8, 12-13, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Menezes et al (US 4,365,313) in view of O'Connor et al (US 6,591,058 B1).

Regarding claim 2, Menezes et al discloses all the claimed limitations as discussed in claim 1 above except for providing a video port for receiving analog video information from an external source.

O'Connor et al teaches a time shifting video recorder having video input port 102 for receiving analog video information from an external source (col. 1, lines 10-22).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the video input port as taught by O'Conner et al into Menezes et al's system in order to allow the user to select desired video program to be edited.

Regarding claim 7, Menezes et al discloses all the claimed limitations as discussed in claim 1 except for providing wherein the a key frame marker for marking marks abrupt changes in video image sequences, thereby enabling a user to readily locate a beginning and an end of a particular video sequence.

O'Connor et al teaches a time shifting video recorder having scene change detector 1806 for detecting the scene changes so that particular scenes can be accessed (col. 12, lines 50-65).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the scene change detector as taught by O'Connor et al into Menezes et al's system in order to simplify in searching for the particular scenes.

Regarding claim 8, the claimed wherein the a key frame marker for marking marks positions in a sequence of said digital data at selectable time intervals is anticipated by the scene change detector of O'Connor et al.

Method claim 12 is rejected for the same reasons as discussed in the corresponding apparatus claim 7 above.

Method claim 13 is rejected for the same reasons as discussed in the corresponding apparatus claim 8 above.

Claim 20 is rejected for the same reasons as discussed in claims 7-8 above.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai Tran whose telephone number is (571) 272-7382. The examiner can normally be reached on Mon. to Friday, 8:00 AM to 5:30 PM.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TTQ



THAI TRAN
PRIMARY EXAMINER